

Application No. 09/941,901
Reply to August 27, 2004 Office Action
Amendment dated January 27, 2005

Remarks

I. Summary of Office Action

Claims 1-9 and 11-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-9, 11, 13, and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin U.S. Patent 4,992,940 (hereinafter "Dworkin") in view of the Examiner's assertion of Official Notice.

Claims 10 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin in view of Official Notice as applied to claim 1 above, and further in view of Woolston U.S. Patent 6,085,176 (hereinafter "Woolston").

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin in view of Official Notice as applied to claim 1 above, and further in view of Akazawa U.S. Patent Application Publication No. US2002/0113809 (hereinafter "Akazawa").

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II. Summary of Applicants' Reply

Claims 1-20 were pending in this application.

Applicants have amended claims 1, 15, and 16 to more particularly define the invention.

Applicants respectfully traverse each rejection.

III. Applicants' Reply to the Rejection under § 101

Claims 1-9 and 11-20 were rejected under 35 U.S.C. § 101 because the claimed subject matter does not recite a limitation in the technical arts. Applicants respectfully traverse this rejection.

Applicants have amended independent claims 1, 15, and 16 to include the limitation of a computer processor into the body of the claims. Accordingly, applicants respectfully submit that the rejection of claims 1-9 and 11-20 be withdrawn.

IV. Applicants' Reply to the § 103(a)
Rejection of Claims 1-9, 11, 13, and 15-17

Claims 1-9, 11, 13, and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin in view of the Examiner's assertion of Official Notice. Applicants respectfully traverse this rejection.

A. Independent Claim 1

Applicants' independent claim 1 refers to a method using a computer processor for interactively assisting purchase decision-making. Applicants' invention advantageously enables a user to use a service to select from several broad purchase categories (e.g., shopping, investing, traveling, etc.) and then enable the user to respond to questions, which results in the display of subcategories of a selected purchase category based on the responses until a purchase is made final (Applicants' specification, page 4, lines 1-15). Claim 1 specifies receiving data relating to purchasing options. The options include shopping and investing. Claim 1 specifies querying based on the data, receiving a response to the querying, and guiding purchase decision-making based on the data and the response until a final purchase selection is indicated. Claim 1 has been amended to specify that the receiving data, querying, receiving a response, and guiding purchase decision-making features are performed using at least one computer processor.

Dworkin refers to a system and method that enables a user to locate products or services, sold by a variety of vendors or suppliers, and having a desired set of

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specifications (Dworkin, column 3, lines 48-51). The system enables the user to "shop" for products meeting the user's own minimum requirements, without the need to consult individual catalogs or visit stores (Dworkin, column 3, lines 51-53).

The Examiner admits that Dworkin "fails to explicitly show receiving data related to purchasing options, wherein the options including investing [as specified in claims 1 and 2] and traveling [as specified in claim 3]" (Office Action, page 4, ¶2). Thus, Dworkin fails to show or suggest applicants' feature of "receiving data relating to purchasing options, the options including shopping and investing."

However, notwithstanding the foregoing admission, the Examiner takes Official Notice to contend "that it was old and well known at the time the invention was made to receive data for investing and traveling options (Office Action, page 4, ¶3). The Official Notice does not remedy the deficiencies of Dworkin because merely stating that investing purchasing options are known does not show or suggest that the system of Dworkin can receive data relating to both shopping and investing options, as recited in applicants' claim 1.

Applicants respectfully submit that the Examiner has failed to point to any suggestion or motivation to modify

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Dworkin with the Official Notice to include all the features of applicants' claimed invention. In particular, the Examiner merely states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin with purchasing options specific to investing and traveling because investment and traveling purchasing options are more efficiently conducted using a computer system.

(Office Action, page 4, ¶4).

In fact, applicants respectfully submit that there is no motivation to modify Dworkin because the system of Dworkin receives data for a purchase option of only one particular type or category (e.g., a shopping purchase option). There is no showing or suggestion that the system of Dworkin can accommodate more than one type of purchase option, thereby limiting users of the system to just one category of purchase options. This shortcoming is overcome with applicants' invention, which specifies an interactive purchasing system that receives data relating to purchasing options for both shopping and investing; that is, applicants' system enables a user to choose one of multiple purchase options.

Moreover, even if there was motivation to modify Dworkin (there is none), the modification would merely

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substitute one purchase option category for another because Dworkin fails to show or suggest receiving data for more than one purchase option category.

As stated above, claim 1 specifies receiving data relating to purchasing options, including shopping and investing options. Significantly lacking in Dworkin is any suggestion of any detail wherein purchasing options include both shopping and investing purchasing options, which is what applicants claim. The Official Notice does not remedy the deficiencies of Dworkin because merely stating that investing purchasing options are known does show or suggest that the system of Dworkin can receive data relating to both shopping and investing options.

Therefore, because both Dworkin and the Official Notice, whether taken alone or in combination, fail to show or suggest all the features of applicants' claimed invention, and because there is no prior art motivation to modify Dworkin to include all the features of applicants' claimed invention, applicants' independent claim 1 is in condition for allowance. Claims 2-14, which depend from independent claim 1, are also in condition for allowance.

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B. Independent Claims 15 and 16

The Examiner rejected independent claims 15 and 16 using the same analysis set forth above used to reject independent claim 1.

Independent claims 15 and 16 specify receiving data relating to purchase options, the options including shopping and investing. As demonstrated above in Section IV.A, Dworkin and the Official Notice, whether taken alone or in combination, fail to show or suggest receiving data relating to purchase options, the options including shopping and investing, as specified in independent claims 15 and 16, independent claims 15 and 16 are in condition for allowance. Dependent claim 17, which depends from independent claim 16, is also in condition for allowance.

C. Official Notice

If the Examiner maintains this obviousness rejection based on Official Notice, then applicants respectfully request that the Examiner provide a reference which shows receiving data, using at least one computer processor, relating to purchasing options, the options including investing and traveling, as is applicants' right under MPEP §§ 2144-2133.03.

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MPEP § 2144.03 requires that the facts of which notice are being taken be "capable of instant and unquestionable demonstration as being 'well-known' in the art. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)."

Applicants believe that the "facts" of which the Examiner has taken official notice do not meet that standard, and invoke their right under MPEP § 2144.03 to have the Examiner provide documentary proof that those facts are actually well known. In summary, applicants believe that the rejections based on "official notice" are improper and unsupportable.

V. Applicants' Reply to the § 103(a)
Rejection of Claims 10, 12, 14, and 18-20

Claims 10 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin in view of the Official Notice as applied to claim 1 above, and further in view of Woolston.

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin in view of the

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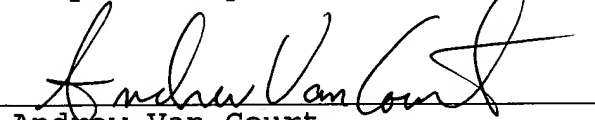
Official Notice as applied to claim 1 above, and further in
view of Akazawa.

At least because applicants have demonstrated in
Section IV of the foregoing that independent claims 1, 15, and
16 are in condition for allowance, dependent claims 10, 12, 14,
and 18-20 are also in condition for allowance.

VII. Conclusion

Applicants submit that this application is in
condition for allowance. Accordingly, prompt consideration and
allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", is written over a horizontal line.

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